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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/627,504 | 07/25/2003 | David A. Bulpett | B03-50 | 3239 |
| 40990 | 7590 | 08/05/2005 | EXAMINER | |
| ACUSHNET COMPANY 333 BRIDGE STREET P. O. BOX 965 FAIRHAVEN, MA 02719 | | | BUTTNER, DAVID J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,504

Applicant(s)

BULPETT ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed benzoate does not fall within the limitations of claim 1. Claim 1 does not permit the formamidine structure.

Claims 1-20, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Peter '313 Patent in view of Megna '919 or the Chu article in the Journal of Biomedical Materials Research.

Peter produces golf ball covers from a diisocyanate/polyol prepolymer and an aromatic polyamine (e.g. Example 1).

UV stabilizers such as benzotriazoles and benzophenones especially in combination with hindered amine light stabilizers can be added to color stabilize the cover (col. 10, line 54-58). Peter does not suggest benzoate stabilizers.

Benzoates such as Tinuvin120 and benzotriazoles are known as alternative stabilizers for polyurethanes (see Megna col 10 line 51,57). Chu actually exemplifies the inclusion of AM340 (equivalent to Tinuvin120) in polyurethanes (tables I and IV).

It would have been obvious to use any UV stabilizer or combination thereof for use in Peter's ball.

It is assumed Peter's ball would have the required color stability, because applicant's disclosure (page 21 line 3) indicates Tinuvin120 would be effective.

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Claims 1-20, 22-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Dewanjee WO 98/37929 Patent in view of Megna '919 or Chu article in the Journal of Biomedical Materials Research.

Dewanjee discloses polyurethane covers for two or three piece golf balls. The polyurethane is made from a diisocyanate prepolymer and amine curative (abstract). A stabilizing package (page 12, line 11) may be included.

There are many stabilizers for urethanes. Megna (col 10 line 57) suggests Tinuvin120 as a stabilizer for polyurethanes. Chu actually exemplifies the inclusion of AM340 (equivalent to Tinuvin120) in polyurethanes (tables I and IV).

It would have been obvious to use any stabilizer or stabilizer combination for use in Dewanjee's ball. Presumably, the ball would have the required color stability because applicant's disclosure indicates Tinuvin120 (page 21 line 3) would be effective.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Peter '313 Patent in view of Speelman '405.

Peter produces golf ball covers from a diisocyanate/polyol prepolymer and an aromatic polyamine (e.g. Example 1).

UV stabilizers such as benzotriazoles and benzophenones especially in combination with hindered amine light stabilizers can be added to color stabilize the cover (col. 10, line 54-58). Peter does not suggest formamidine stabilizers.

There are many stabilizers for urethanes. Speelman exemplifies formamidine stabilizers in polyurethanes.

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It would have been obvious to use any UV stabilizer or combination thereof for use in Peter's ball.

It is assumed Peter's ball would have the required color stability, because applicant's disclosure (page 21 line 1,18) indicates formamidines would be effective.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Dewanjee WO 98/37929 Patent in view of Speelman '405.

Dewanjee discloses polyurethane covers for two or three piece golf balls. The polyurethane is made from a diisocyanate prepolymer and amine curative (abstract). A stabilizing package (page 12, line 11) may be included. Formamidine stabilizers are not suggested.

There are many stabilizers for urethanes. Speelman exemplifies formamidine stabilizers in polyurethanes.

It would have been obvious to use any stabilizer or stabilizer combination for use in Dewanjee's ball. Presumably, the ball would have the required color stability because applicant's disclosure indicates formamidines (page 21 line 1,18) would be effective.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10-384422. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims (#8,9) golf balls having benzoate stabilizers in combination with light stabilizers in the cover.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed 5/18/05 have been fully considered but they are not persuasive. Arguments that the limitation on species of stabilizer overcomes the previous rejections are convincing. However, the new set of rejections are directed to the narrowed species of stabilizer.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner
8/2/05

